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OFFICE OF PETITIONS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)
)
Robert A. FERSTENBERG et al.)
)
Serial No. 09/209,815)
)
Filed: December 11, 1998)
)
For: COMPUTER METHOD AND SYSTEM) July 31, 2002
FOR INTERMEDIATE EXCHANGE)
OF COMMODITIES)

ATTENTION: DIRECTOR, GROUP 36
EXPEDITED CONSIDERATION
REQUESTED

Examiner: James W. Myhre

Group Art Unit: 3622

July 31, 2002

PETITION TO THE COMMISSIONER UNDER 37 CFR § 1.181(a)(3)
FOR WITHDRAWAL OF OFFICE ACTION FINALITY AND ENTRY OF AMENDMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Applicants hereby petition the Commissioner to invoke his supervisory authority pursuant to 37 CFR § 1.181(a)(3). Expedited consideration of this petition is requested as a Notice of Appeal has been filed simultaneously herewith.

Applicants request the Commissioner to withdraw the finality of the outstanding Office action dated May 3, 2002, on the grounds that it was premature. Consequently or alternatively, Applicants request that the amendment filed June 14, 2002 be entered. Applicants have requested reconsideration of the finality of the Office action in their first response to the final Office action, filed June 14, 2002. That request was denied in an Advisory action mailed on June 26, 2002, in which

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the Examiner additionally refused to enter Applicants' amendment upon appeal.

According to MPEP § 706.07(a), second or subsequent actions on the merits should not be made final where the examiner introduces new grounds of rejection not necessitated by either applicant's amendment or by new information submitted in an information disclosure statement.

In the present case, the outstanding Office action of May 3, 2002 introduced three new grounds of rejection of claims 139 and 147 under the second and fourth paragraphs of 35 U.S.C. § 112, and under 35 U.S.C. § 101. These new grounds of rejection were not necessitated by any amendment made by applicants or by any information submitted in an IDS. The Advisory action mailed June 26, 2002 refused to enter Applicants' amendment filed June 14, 2002 on the grounds that it allegedly does not "place the application in better form for appeal by materially reducing or simplifying the issues for appeal."

The refusal to withdraw the finality of the outstanding Action on this basis constitutes an abuse of discretion. It is undisputed that the new grounds of rejection of claims 139 and 147 were not necessitated by applicant's amendment. Applicants should be given the right to respond to new grounds of rejection which were not caused by amendment, and not be prematurely cut off from prosecution.

In the present case, Applicants' right to appeal from the final rejection is being hampered by the Examiner's refusal to

enter Applicants' proposed amendments which address the new grounds of rejection. The Advisory action has not alleged that the amendments require any further search or consideration, but to the contrary the Examiner has already considered the amendment in deeming it "ineffective in overcoming the 35 U.S.C. 112 and 101 rejections." Applicants should have the right to subject this determination by the Examiner to review by the Board of Patent Appeals. No purpose whatsoever would be served by forcing Applicants to file a continuation application in order for Applicants to properly present their appeal to the Board of Patent Appeals and Interferences.

Conclusion and Relief Requested

In view of the foregoing, the Commissioner is respectfully requested to direct that the finality of the outstanding Office action of May 3, 2002 be withdrawn, and that the amendment filed June 14, 2002 be entered in the present application.

Please charge any fee or credit any overpayment pursuant to 37 CFR 1.16 or 1.17 to Deposit Account No. 02-2135.

Respectfully submitted,

ROTHWELL, FIGG, ERNST & MANBECK, p.c.

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